

## **REMARKS**

Applicant has studied the Office Action dated October 24, 2006. It is submitted that the application, as previously amended, is in condition for allowance. Claims 1-22 are pending. Reconsideration and allowance of the pending claims in view of the following remarks is respectfully requested.

In the Office Action, the Examiner:

- (3-4) rejected claims 1-15 and 17-22 under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. (U.S. Patent No. 6,779,040) in view of Holtz et al. (U.S. Patent Pub. No. 20020053078 A1); and
- (5) rejected claims 16-18 under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. (U.S. Patent No. 6,779,040) and Holtz et al. (U.S. Patent Pub. No. 20020053078 A1) in view of Salo et al. (U.S. Patent No. 6,563,800).

### **(3-4) Rejection under 35 U.S.C. §103(a) Lee et al. in view of Holtz et al.**

As noted above, the Examiner rejected claims 1-15 and 17-22 under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. (U.S. Patent No. 6,779,040) in view of Holtz et al. (U.S. Patent Pub. No. 2002/0053078 A1).

The presently claimed invention determines image delivery parameters and image presentation parameters (session information) and passes this information along with requests for media from a web content server. Instant specification, pages 21-22. The session information, transmitted as part of a header of information packets transmitted across a network, contains this transmission information. The present invention is thereby able to react to changes in network connections or conditions and to changes in device capabilities by tailoring the media to the image delivery parameter and the image presentation parameter that accompanies each image request.

As correctly recognized by the Examiner on page 4 of the above-identified Office

Action, "Lee et al. does not explicitly indicate the request including a session information pertaining to the current communication session between the networked device and a server, the session information being separate from the request for delivery of image information and the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information." The Examiner goes on to combine Holtz et al.

In order to establish a prima facie case of obviousness by modifying or combining reference teachings, MPEP § 2143 requires that:

- there must be some suggestion or motivation to combine the references in the prior art;
- there must be a reasonable expectation of success to be found in the prior art; and
- the prior art references must teach or suggest all the claim limitations.

It is believed that not one of the three criteria has been met. The Examiner only states "refer to abstract." A purely general remark towards the known advantageous material characteristics of "keeping information such as session information" is insufficient in order to justify a rejection under 35 U.S.C. § 103. There is no motivation found or alleged to be found in Lee et al. There are no recited deficiencies in Lee et al. that would require combining additional art to arrive at a different invention. There is also no motivation found or alleged to be found in Holz et al. to combine the references.

Notwithstanding the improper combination of references, Holtz does not teach, show, or suggest those elements that are claimed in the instant application and are absent from Lee. Holtz discloses a multimedia production and distribution system where a client can select various options to customize the transmission from the server to the client. Holtz Abstract. As is shown in FIG. 15 of Holtz, when a user wishes to customize the transmission, he requests an enhanced media viewer, which is sent from the server to the requesting client. Holtz, para. 0114. Only after the client receives the viewer can he then receive enhanced media segments. Holtz, para. 0118, and FIG. 16. These segments can be displayed on the viewer. Holtz, FIG. 16.

Importantly, a client using the Holtz invention determines the display preferences at a particular time and then all requests for media after that time are sent in conformance with the request and are viewable on the media player that was previously sent from the server to the client. Holtz, para. 0027. Holtz is not concerned with current device or network conditions and/or capabilities, as is the present invention. Holtz does not send "parameters," but instead sends requests for file formats. If a user using the Holtz invention made a request for media in a particular format and subsequently, network conditions or connection type changed, the Holtz invention would not respond to accommodate those changes, as would the present invention. In other words, Holtz is not concerned with parameters.

Furthermore, Holtz is able to request transmission types, such as downloaded, streamed, or saved to the client. Holtz, para. 0026. However, these requests are not made by transmitting parameters, but are instead made by specifically requesting a particular transmission method.

Therefore, Holtz does not teach, show, or suggest "receiving...session information pertaining to a current communication session...the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information," as is recited in independent claims 1, 2, 3, 7, 9, 11, and 13, and for all dependent claims, depending there from, respectively.

When there is no suggestion or teaching in the prior art, the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Lee et al. taken alone and/or in view of Holtz et al. do not teach or suggest the limitations of claims 1, 2, 3, 7, 9, 11, or 13. Accordingly, claims 1, 2, 3, 7, 9, 11, and 13, and for all dependent claims, depending there from,

respectively, distinguish over Lee et al. taken alone and/or in view of Holtz et al. for this reason as well.

In view of the remarks above, since neither Lee et al., Holtz et al., nor any combination of the two cited references, teaches, anticipates, or suggests, the presently claimed invention, for example, "determining, based on the image delivery parameter and the image presentation parameter" and "the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information," the Examiner should withdraw the rejection of claims 1-15 and 17-22.

**(5) Rejection under 35 U.S.C. §103(a) Lee et al. and Holtz et al.  
in view of Salo et al.**

As noted above, the Examiner rejected claims 16-18 under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. (U.S. Patent No. 6,779,040) and Holtz et al. (U.S. Patent Pub. No. 20020053078 A1) in view of Salo et al. (U.S. Patent No. 6,563,800).

The deficiencies of Lee et al. and Holtz et al. are discussed in the preceding section entitled "(3-4) Rejection under 35 U.S.C. §103(a) Lee et al. in view of Holtz et al." Claims 16-18 depend from independent Claim 13. Similar to Lee et al. and Holtz et al., Salo neither shows nor suggests the limitations recited in independent claim 13 of the instant application.

Additionally, claim 18 is directed at a **proxy engine** that is used to determine the image format for the image that is to be transmitted across the network to the networked device. See, for example, FIG. 2, elements 248 and 256, of the instant application. The proxy engine may be located at the same server that is in direct communication with the networked device (see FIG. 2, elements 238 and 240), or, alternatively, the proxy engine can be located at a proxy server that is separate and remote across the network from the server that is in direct communication with the networked device (see FIG. 2, elements 248 and 256). This is significantly different than the teachings of Lee.

**Lee et al. do not disclose a proxy server (e.g., or a proxy engine),** and certainly do not teach or suggest a proxy server, or a proxy engine, for determining image format for image information. In Lee et al., the determining is performed at the receiving server based on the information contained in the **request to register client computer capabilities and user preference parameters.** See Lee et al. col. 11, lines 41-47, and col. 12, line 14-48, and lines 52-59. Lee et al. do not teach or suggest the determining of image format being performed with the assistance of an image format determining proxy server (e.g., proxy engine), as taught and claimed for the present inventive method and system.

In addition, an image proxy engine for determining the image format is not taught or anticipated by Holtz et al. or by Salo et al., or by any combination thereof.

It is accordingly believed that Lee et al., whether taken alone or in any combination with Holtz et al. and/or Salo et al. neither shows nor suggests the features of independent Claim 13. Claim 13 is, therefore, believed to be patentable over the cited prior art. Dependent Claims 16-18 are believed to be patentable as well because they all are dependent from allowable Claim 13. Further, original dependent Claim 18 additionally recites novel and allowable subject matter over the teachings of Lee et al., Holtz et al., and Salo et al., or any combination of the cited references.

Continuing further, when there is no suggestion or teaching in the prior art, the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Lee et al., taken alone, and/or Holtz et al. and/or in view of Salo et al. do not teach or suggest the limitations of Claim 13. Accordingly, Claims 16-18 distinguish over Lee et al. taken alone and/or in view of Holtz et al. and/or in view of Salo et al. for this reason as well.

In view of the remarks above, since neither Lee et al., Holtz et al, Salo et al., nor any combination of the cited references, teaches, anticipates, or suggests, the presently claimed, for example, "determining, based on the image delivery parameter and the image presentation parameter" and "the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information", and further, as recited for dependent Claim 18, that the "image proxy engine, responsive to the API calls, for determining, based on at least one of an image delivery parameter and an image presentation parameter associated with the at least one networked device, the image format for the image information", Applicant believes that the rejection of Claims 16-18 under 35 U.S.C. 103(a) has been overcome. The Examiner should withdraw the rejection of these claims.

### **CONCLUSION**

The foregoing is submitted as full and complete response to the Official Action mailed October 24, 2006, and it is submitted that Claims 1-22 are in condition for allowance. Allowance of Claims 1-22 is earnestly solicited.

**If the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, or that in any way it would help expedite the prosecution of the patent application, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.**


The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account **50-1556**.

In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

Respectfully submitted,

Date: January 24, 2007

By:

A handwritten signature in black ink, appearing to read "Jose Gutman", written over a horizontal line.

Jose Gutman

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